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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/790,217	03/02/2004	Akira Yoneoka	P21-163407M/NY	9855
21254	7590	06/21/2006	EXAMINER	
MCGINN INTELLECTUAL PROPERTY LAW GROUP, PLLC 8321 OLD COURTHOUSE ROAD SUITE 200 VIENNA, VA 22182-3817			MITCHELL, KATHERINE W	
			ART UNIT	PAPER NUMBER
			3677	

DATE MAILED: 06/21/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/790,217

Applicant(s)

YONEOKA, AKIRA

Examiner

Katherine W. Mitchell

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 April 2006.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 4/26/2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attach/Int(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION***Continued Examination Under 37 CFR 1.114***

1. The request filed on 4/11/2006 for a Request for Continuing Examination (RCE) under 37 CFR 1.114 is acceptable and an RCE has been established. Any previous finality is hereby withdrawn and a new action on the merits follows. Any newly-submitted claims have been added. An action on the RCE follows.

Election/Restrictions

- A first invention provides a jointing member having: a grommet and a pin, *wherein the grommet includes a flange portion and a leg portion capable of being opened, in which an insertion hole is formed from a center of the flange portion to an inner portion of the leg portion in which a lower end of the leg portion is opened, and an engagement portion is formed at an inner surface of the leg portion, and the pin includes a head portion and a shaft portion to be inserted into the insertion hole, in which an engagement surface and a lock surface each engagable with the engagement portions are formed at the shaft portion.*
- *In a second invention, in a state where the engagement portion formed at the leg portion of the grommet engages with the engagement surface formed at the shaft portion of the pin, the pin is movable in its drawing out direction within the insertion hole of the grommet.*
- *In a third invention, the engagement portion formed at the leg portion of the grommet engages with the lock surface formed at the leg portion of the shaft portion as the engagement portion moves along the lock surface while maintaining the opened state of the leg portion of the grommet.*
- *In a fourth invention, in a state where the engagement portion formed at the leg portion of the grommet engages with the engagement surface formed at the shaft portion of the pin, a tip end of the shaft portion of the pin is buried within the insertion hole of the grommet.*

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- *In a fifth invention, the tip of the shaft portion of the pin, which is provided with the lock surface, is surrounded with the extending portion of each of leg portions of the grommet in a state that the grommet and the pin are incorporated to be the leg portions opened, and is inside the tip hole portion of the grommet.*
- *In a sixth invention, the predetermined distance that the grommet and the pin enable to slide is 0.5 mm to 2 mm. Therefore, in order to disengage the pin, it is possible to hitch with a tip of a finger or a tip of a slotted screw driver, as well as it is possible to design the jointing member to be compact in the entire length.*

If these are not 6 inventions, but rather six features of an invention, then the wording should be appropriately changed to prevent confusion.

Specification

2. A substitute specification showing all the changes of the past 3 amendments is required pursuant to 37 CFR 1.125(a) because there are multiple changes to the same sections, and changes to different sections in specific amendments. It is hard to reconcile the specification with the drawings and the claims.

A substitute specification must not contain new matter. The substitute specification must be submitted with markings showing all the changes relative to the immediate prior version of the specification of record. The text of any added subject matter must be shown by underlining the added text. The text of any deleted matter must be shown by strike-through except that double brackets placed before and after the deleted characters may be used to show deletion of five or fewer consecutive characters. The text of any deleted subject matter must be shown by being placed within double brackets if strike-through cannot be easily perceived. An accompanying

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clean version (without markings) and a statement that the substitute specification contains no new matter must also be supplied. Numbering the paragraphs of the specification of record is not considered a change that must be shown.

As is likely apparent, examiner is having trouble following the description. For example, as discussed in the 112 rejections below, where is the "large diameter portion (of the flange portion) as claimed in claim 9 described or shown? How can flange portion ("3") comprise an extending portion ("22") which seem to examiner to be part of the leg portion? As another example, looking at amended paragraph on page 6, beginning on line 13: "The diameter of the pin hole portion {note -- this must be part of flange portion 3--examiner} is smaller than a diameter of the large-diameter portion {what is this--examiner} in a free state {what is this--examiner} on a side of a tip {what is a side of a tip??} far from the flange portion. Further, what exactly is in a free state -- the large diameter portion? What is modified by "on a side of a tip". Note that the flange portion comprises a large diameter portion...an engagement hole where the bottom of the large-diameter portion is adjacent, and an extending portion...to form a pin hole portion.... All of these are part of the flange portion, so what is on a side of a tip that is far from the flange portion?

Referring to paragraph [0024] "An embodiment of the invention will be explained with reference to the drawings. Like the conventional jointing member, as shown in FIG. 1, a jointing member of the embodiment is also configured from a grommet 1 and a pin. " This is stating that Fig 1 is a conventional jointing member. In that case, the figure should have a "PRIOR ART" label, but it appears that the claimed invention is all

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based on Fig 1 and various details and cuts of Fig 1. Is Fig 1 prior art, or does it show the claimed invention?

Examiner is not going to continue going through sentence by sentence to question what is meant. Examiner has spent literally 10 hours trying to figure out what is being described and what is claimed, and still finds that there are numerous instances where the application is unclear.

Drawings

3. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the Large-diameter portion of flange portion of grommet (claim 9) must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New

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Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 1-20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claims are replete with examples of unclear and imprecise terms, including lack of proper antecedent basis, unclear structural details, and confusing wording. Examples include but are NOT limited to the following:

6. In claim 1, assuming the pin shaft was already inserted in the insertion hole, how are engagement surface and lock surface each engagable with the engagement portion when the shaft is inserted in the insertion hole--it appears to examiner in the figures that only one of the engagement surface or lock surface can engage the engagement portion at any position or state. This seems impossible based on the described structure.

- o Looking at claim 9: the flange portion of the grommet comprises a large diameter portion of the insertion hole...and an extending portion which is extended to form a pinhole portion whose diameter is smaller than that of the large diameter portion in a free state on a side of a tip that is far from the flange portion...." WHAT does this mean??? Where is the large diameter

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portion defined in the spec or labeled in the drawings? Is it the outer edge of 3/10? Is it the inner edge of "3"? "3" is the flange portion - everything that comprises this flange portion must then be part of "3". Examiner has spent hours trying to figure out what is meant by this section and cannot understand it.

- o The figures show rib walls 12 on pins, so the projection is assumed to be on the grommet. Spec discloses projections 11, shown as recess, not projection. Is applicant considering a recess to be a –hole projection–, which is contradictory to the accepted meaning of projection. Where applicant acts as his or her own lexicographer to specifically define a term of a claim contrary to its ordinary meaning, the written description must clearly redefine the claim term and set forth the uncommon definition so as to put one reasonably skilled in the art on notice that the applicant intended to so redefine that claim term. *Process Control Corp. v. HydReclaim Corp.*, 190 F.3d 1350, 1357, 52 USPQ2d 1029, 1033 (Fed. Cir. 1999). The term is indefinite because the specification does not clearly redefine the term.

Examiner cannot comprehend what applicant is trying to describe or claim.

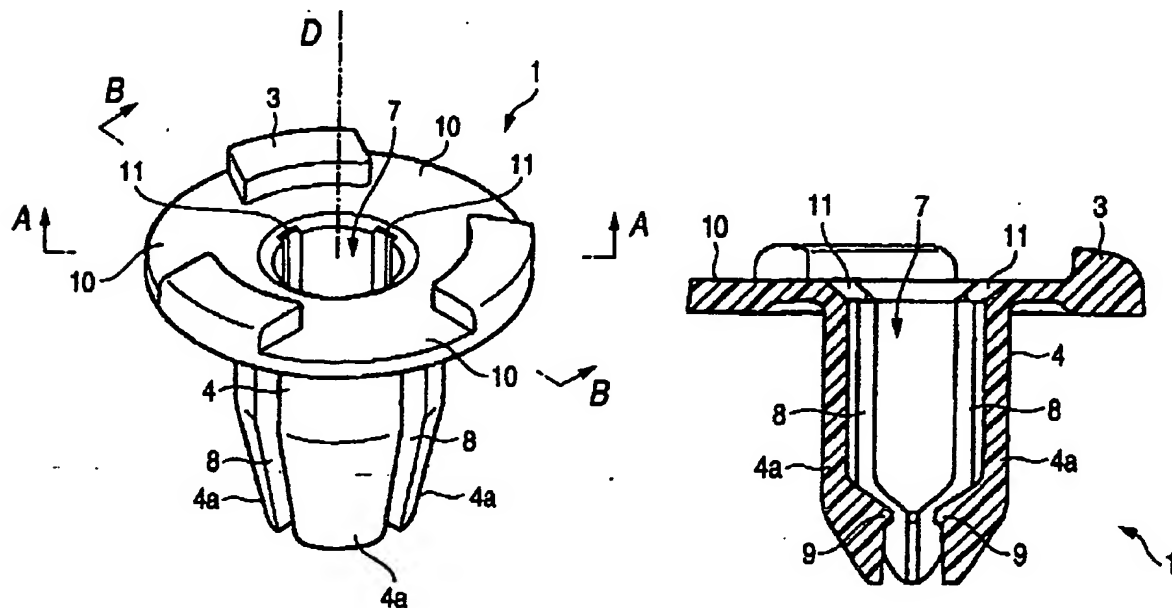
Below are the only original disclosures of projection on {an edge of} said slits:

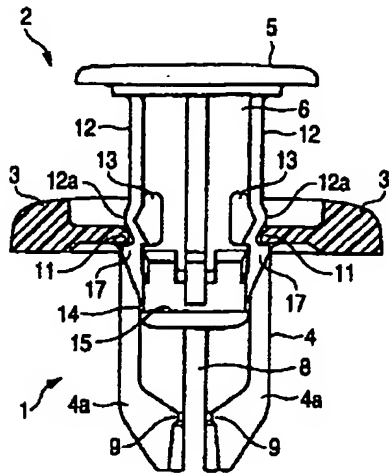
[0025] As shown in FIGS. 2A and 2B, in the grommet 1, an insertion hole 7 to insert the shaft portion 6 of the pin 2 therein is formed from a center of the flange portion 3 to an inner portion of the leg portion 4. The leg portion 4 is divided into plural pieces through four slits 8 so that the pieces can be opened outward. An engagement nail 9 which engages with a engagement surface 14 and a lock surface 15 of the pin 2 described later is formed at the inner surface of an expanded tip end side of each of the divided leg pieces 4a. A plurality of tool insertion grooves 10 extending in the radial direction are

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formed on the upper surface of the flange portion 3. **A projection 11 for provisional engagement is formed at the hole edge on the flange portion 3 side of each of the slits 8.** An extending portion 22 is provided to be extended to form a pin hole portion 21 at the tip of the leg portion 4.

[0028] In the case of jointing and fixing two panel members P1, P2 to each other by using the jointing member thus configured, the shaft portion 6 of the pin 2 is inserted within the insertion hole 7 of the grommet 1 while coinciding the positional relation between the slits 8 and the rib walls 12. Thus, as shown in FIG. 4, **the projection 11 for provisional engagement, which is formed at the hole edge on the flange portion 3 side of each of the slits 8, is elastically engaged with a portion between a root of the elastic arm portion 12a and the projection 17 of the rib walls 12 of the pin 2.** As a result, the pin 2 becomes to be provisionally engaged with the grommet 1 with reliability. In this state, each of the divided leg pieces 4a is not yet opened outward.





How projection "11" correlates in Figs 1, 2A and 4 above, with the specification and claim 17 is unclear. Applicant should explicitly clarify.

Re claim 18: The grammar of claim 18 requires the slits to be formed on an outer periphery of said shaft portion, which is part of the pin:

18. (Previously Presented) The jointing member according to claim 17, further comprising:

a plurality of rib walls for engaging said plurality of slits formed on an outer periphery of said shaft portion.

Note that "said plurality of slits formed on an outer periphery of said shaft portion" lacks antecedent basis. However, the rib walls are also required to be on the pin, since claim 17 has the projection on an edge of said slits engaging the rib wall, and all figures show ribs 12 on the pin. For engagement, the projection and slit must be on different parts - one on the pin, one on the grommet. If the slits are on the pin, and the ribs (shown clearly as 12 on the pin in the figures) are on the pin, how do they engage each other? If applicant

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means the rib walls are formed on an outer periphery of said shaft portion, the claim MUST be reworded. Examiner considers claims 17-20 unexamined, as the previous 112 rejection required clarification of all claims.

7. Claims 2-8 and 10-20 are rejected as depending from claims 1 or 9.

Again, these are NON-LIMITING examples only. Claims must be definite and unambiguous. One of ordinary skill with average knowledge of the English language and terminology should be able to read the claims and understand the invention.

Applicant needs to completely review each claim and ensure that the claims are clear and definite.

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. As best understood by examiner, claims 1- 8 and 12-14, and 21 are rejected under 35 U.S.C. 102(b) as being anticipated by Ueno USP 5846040, OR Anderson USP 5286152 OR Plimi Jr USP 6324731. .

Re claim 1: Ueno OR Anderson OR Plimi Jr teach a jointing member comprising a grommet and pin. The grommet has a flange and leg portions, capable of being opened, and there is an insertion hole in the center of the flange to an inner portion of the leg. There is an engagement portion on the leg portion. The pin includes a head and shaft, said shaft insertable in the insertion hole of the grommet, the shaft has an

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engagement surface and a lock surface each engageable with the engagement portion.

The distance from the grommet flange to the grommet leg portion tip is greater than a

distance from the pin head to the pin tip.

UENO:

FIG. 5

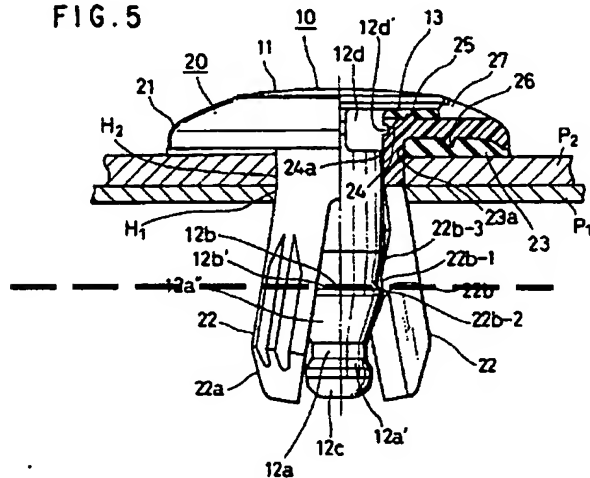
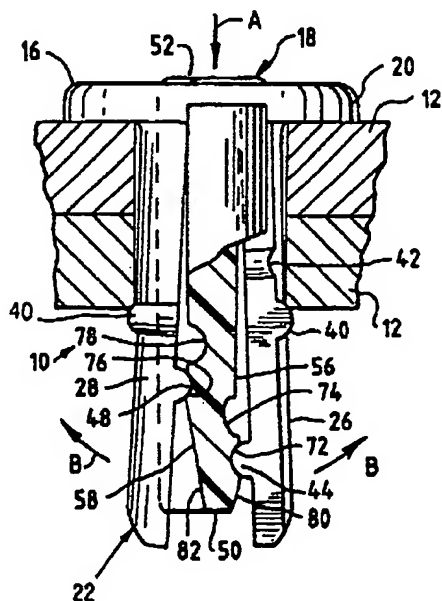
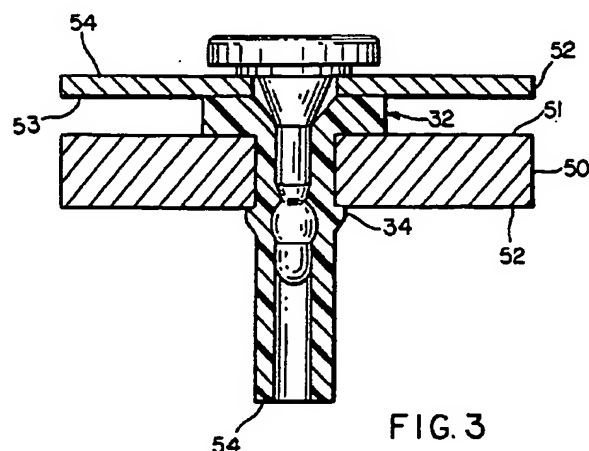


FIG 23



Plimi Jr.



Re claim 2; The pin is axially movable when the grommet engagement portion engages the pin engagement surface.

Re claims 3,4: The grommet engagement portion engages the pin lock surface when the pin moves along the lock surface while maintaining the leg portion in an open state.

Re claims 5,6,7,8: The tip end of the shaft portion is buried in the grommet insertion hole when the grommet engagement portion engages the pin engagement surface.

Re claim 12; The engagement portion comprises a protruding portion extending from the leg inner surface.

Re claim 13: There are a plurality of slits in the grommet dividing the leg into a plurality of leg pieces.

Re claim 14: The engagement portion is formed on the inner surface of this tip end side.

Re claim 21: The distance from the grommet flange to the grommet engagement portion is smaller than the distance from the pinhead to the pin lock

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10. As best understood by examiner, claims 1- 8 and 12-14, and 21 are rejected under 35 U.S.C. 102(b) as being anticipated by LeVey USP 6045309.

Re claim 1: LeVey teaches jointing member comprising a grommet 14 and pin 12. The grommet has a flange and leg portions, capable of being opened, and there is an insertion hole in the center of the flange to an inner portion of the leg. A lower end of the leg portion is opened, (between 77 and 78 is opened, and this is at a lower end) although it is not a through opening through the axial tip. There is an engagement portion (75,76, Fig 9 and 10, col 4 lines 34-53) on the leg portion. The pin includes a head and shaft, said shaft insertable in the insertion hole of the grommet, the shaft has an engagement surface (40 to 46 below) and a lock surface (at 48,50) each engageable with the engagement portion. The distance from the grommet flange to the grommet leg portion tip is greater than a distance from the pin head to the pin tip.

Re claim 2; The pin is axially movable when the grommet engagement portion engages the pin engagement surface.

Re claims 3,4: The grommet engagement portion engages the pin lock surface when the pin moves along the lock surface while maintaining the leg portion in an open state.

Re claims 5,6,7,8: The tip end of the shaft portion is buried in the grommet insertion hole when the grommet engagement portion engages the pin engagement surface.

Re claim 12; The engagement portion comprises a protruding portion extending from the leg inner surface - see Fig 1 and 9.

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Re claim 13: There are a plurality of slits (best seen Fig 1 – between leg portions 77,78, in the grommet dividing the leg into a plurality of leg pieces.

Re claim 14: Anything below the dashed line by examiner is considered where an expanded tip end side of the leg begins. Note that Fig 9 shows how this section expands when inserted. The engagement portion is formed on the inner surface of this tip end side.

Re claim 21: The distance from the grommet flange to the grommet engagement portion is smaller than the distance from the pinhead to the pin lock surface (best seen in Fig 9)

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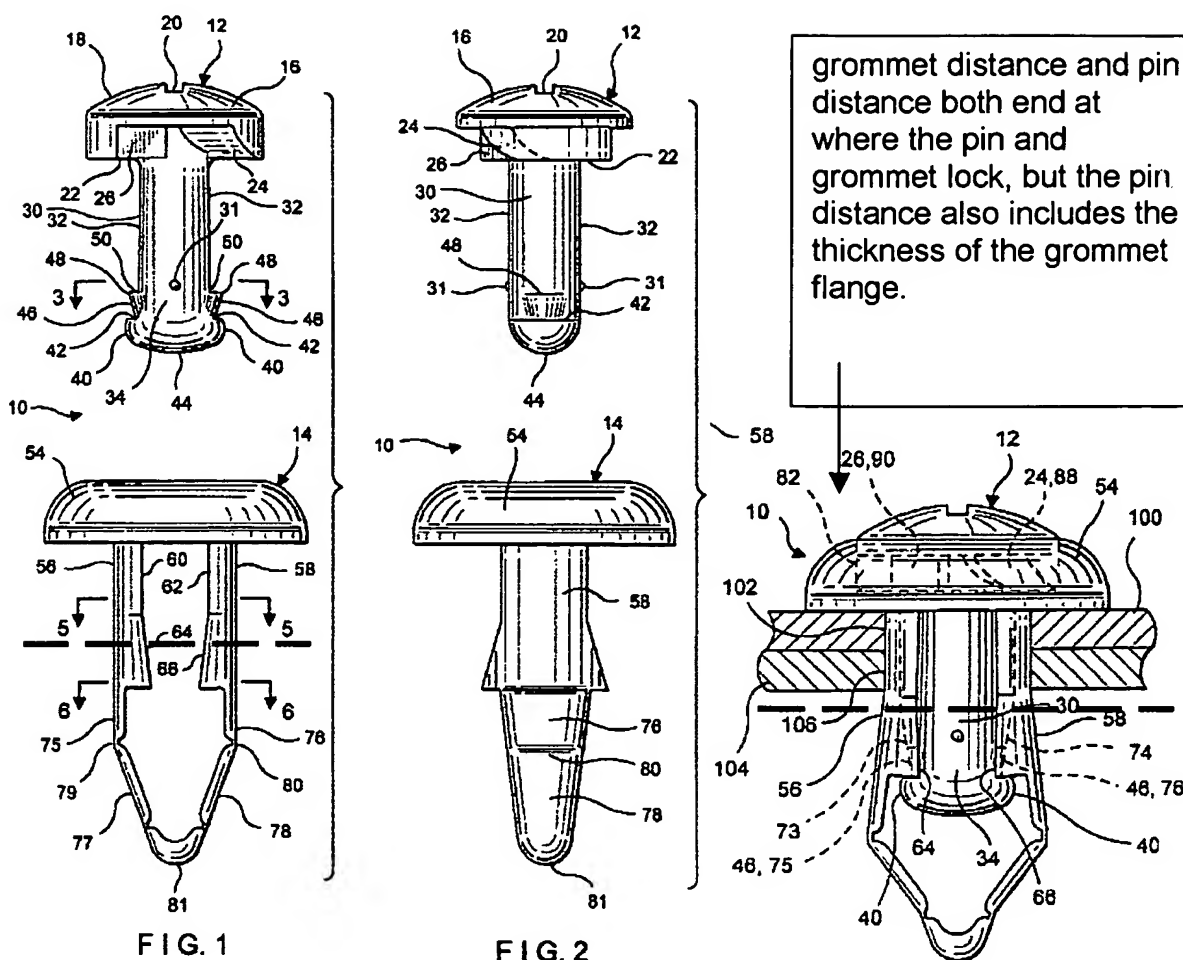


FIG. 1

FIG. 2

Claim Rejections - 35 USC § 103

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. Claims 15-16 rejected under 35 U.S.C. 103(a) as being unpatentable over LeVey or Ueno OR Anderson OR Plimi Jr

Examiner takes Official Notice that a groove for insertion tools extending on a

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flange of a fastener is well known. LeVey shows a plurality of such grooves on the pinhead in Fig 7. Therefore, it would have been obvious to one of ordinary skill in the art, having the teachings of LeVey or Ueno OR Anderson OR Plimi Jr before him at the time the invention was made, to modify either LeVey or Ueno OR Anderson OR Plimi Jr to include tool insertion grooves on the flange of the grommet, in order to obtain easy insertion and orientation of the jointing member. One would have been motivated to make such a combination because such grooves for tools are old and well known, and widely accepted and used in the fastener art.

Allowable Subject Matter

13. Examiner is withholding an opinion on the allowability of claims 9-11 and 17-20 until they can be clarified and reconciled with the specification and drawings.

Response to Arguments

14. Applicant's arguments filed 3/15/2006 with respect to all claims have been considered but are moot in view of the new ground(s) of rejection.

15. Applicant's arguments filed 3/15/2006 have been fully considered but they are not persuasive with respect to LeVey - Levey has an opened lower end of the leg portion. Since a lower end of the leg portion being opened was never claimed prior to this amendment, applicant is correct that examiner did not point it out.

16. Applicant is advised to explain exactly how any future amendment overcomes the specific 112 issues listed above.

Conclusion

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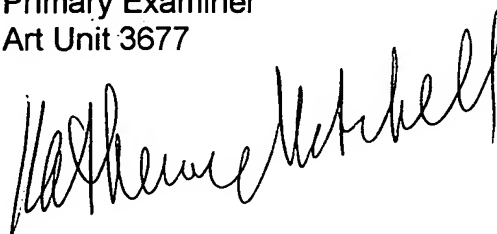
17. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

18. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Katherine W. Mitchell whose telephone number is 571-272-7069. The examiner can normally be reached on Mon - Thurs 10 AM - 8 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, J. J. Swann can be reached on 571-272-7075. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

19. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Katherine W Mitchell
Primary Examiner
Art Unit 3677

A handwritten signature in black ink, appearing to read 'Katherine W. Mitchell', written in a cursive style.

Kwm
6/15/2006